

Response After Final
Application No. 09/871,605
Attorney Docket No. 010713

REMARKS

Claims 1, 3-7 and 9-12 are pending in the application.

Claim Rejections - 35 U.S.C. §112

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete.

The Office Action repeats the same rejection from the previous Office Action. Specifically, the Office Action states that “it is unclear whether said ‘operator’ is a computerized logic module, or a person.” (Office Action, page 6.)

Claims 1 and 7 were amended in the Amendment dated August 8, 2006 to recite that the operator is “a human operator.” Thus the term “operator” in “human operator” cannot be confused with “a computerized logic module.”

Withdrawal of the rejection is requested.

Claim Rejections - 35 U.S.C. §103

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Eisenhart** (U.S. Patent Application Pub. No. 2001/0047276) in view of **Dworkin** (U.S. Patent 6,026,148).

A. Human Operator

Applicant respectfully submits that Eisenhart in view of Dworkin does not disclose:

using a human operator to select members for which provision of information is to be requested, *by utilization of information about the members registered in the membership database*

as recited in claim 1, and

means for a human operator to select members for which provision of information is to be requested, *by utilization of information about the members registered in the membership database*

as recited in claim 7.

Applicant previously pointed out that in Dworkin, either an electronic operator is used or no operator at all is used. (Amendment, August 8, 2006.) Dworkin discloses that a user, and not an operator, can manually select an expert to direct a question to. Dworkin discloses a computer-based system which facilitates the exchange of information between users and expert respondents. (Abstract.) Dworkin discloses that a user logs on to the system and creates a question to store in the memory of the central computer. (Col. 2, lines 5-7.) An expert respondent is then selected, either *manually by the user* or automatically by the system. (Col. 2, lines 7-10.) Dworkin discloses that the system, or electronic operator as alleged by the Examiner, can be bypassed in order for the user to directly ask an expert a question. Thus, Dworkin discloses that either an electronic operator is used or that no operator at all is used.

In response, the Office Action states that Dworkin allows for an expert respondent to be selected manually by the user or automatically by the system. (Office Action, page 3, citing Dworkin, col. 2, lines 7-9.) The Examiner also states that Dworkin allows for a user to select a subject from a menu of possible subjects, and the system would choose an expert according to

the subject selected. (Office Action, page 3, citing Dworkin, col. 7, lines 11-19.) Thus, it is the position of the Office Action that the “user” in Dworkin corresponds with the “human operator” as recited in claims 1 and 7. (Office Action, page 3.)

Even assuming that the “user” in Dworkin corresponds with the “human operator” as recited in claims 1 and 7, as alleged by the Office Action, Dworkin does not disclose that the “user” can select respondents in which to direct questions to “by utilization of information about the members registered in the membership database” as recited in claims 1 and 7.

Dworkin does not disclose that information about the respondents is available for users in order to decide which respondent or respondents to direct a question to. Dworkin discloses posting a picture and biography of an expert respondent after that respondent has answered the question. (Col. 5, lines 27-29.) However, Dworkin does not disclose allowing a user to view biographical information about expert respondents in order to select whom to direct a question to.

Thus, Dworkin does not disclose that a human operator selects members for which provision of information is to be requested. However, even assuming that the “user” in Dworkin corresponds with the “human operator,” as alleged by the Office Action, Dworkin does not disclose that the “user” can select respondents in which to direct questions to “by utilization of information about the members registered in the membership database.” Therefore, Eisenhart in view of Dworkin does not disclose the elements as recited in claims 1 and 7.

B. No Motivation to Combine Eisenhart and Dworkin

Applicant respectfully submits that one of ordinary skill in the art at the time of the present invention would not have been motivated to combine the teachings of Eisenhart and Dworkin.

Dworkin discloses a computer bulletin board or forum for posting questions in which a respondent expert then answers. (Abstract.) By contrast, Eisenhart is concerned with forming business partnerships. (Eisenhart, paragraph 14.) Eisenhart discloses facilitating collaboration between a technology supplier and a buyer of a technology asset. (Abstract.) Since Dworkin and Eisenhart deal with unrelated and non-analogous technologies, one of ordinary skill art would not have been motivated to combine the references.

Moreover, Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart. Dworkin discloses a disadvantage in the art of computer-based bulletin boards is that

when one relies on a number of technical experts, these experts must all have some facility with computers, and must be located near a computer, in order to answer questions.

(Col. 1, lines 45-50.) Dworkin discloses solving this problem by

providing a system and method for dissemination of information, especially expert information, wherein the experts providing the information need not be computer literate, and need not be located near a computer.

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(Col. 1, lines 59-63.) Specifically, Dworkin discloses solving the problem by providing the expert respondent a way to answer questions by speaking the answer in a telephone. (Col. 2, lines 12-14.) Since Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart, one of ordinary skill in the art would not have been motivated to combine the references.

For at least the foregoing reasons, claims 1 and 7 are patentable over the cited references, and claims 3-6 and 9-12 are patentable by virtue of their dependence from either claim 1 or 7.

Accordingly, withdrawal of the rejection of claims 1, 3-7 and 9-12 is hereby solicited.

In view of the above remarks, Applicant submits that that the claims are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'A. Melick', with a stylized flourish at the end.

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